

R E M A R K S

This is in response to the Office Action that was mailed on November 19, 2004. In a sincere effort to advance the prosecution of this application, the claims are limited in scope to preferred embodiments of the inventions disclosed in the present application, and claims 2, 3, 6, 11-17, 19, and 20 are cancelled without prejudice. No new matter is introduced by this Amendment. Claims 1, 4, 5, 7-10, 18, 21, and 22 as amended are pending in the application.

The rejection of claims 19 and 20 under 35 U.S.C. §101 is rendered moot by the cancellation of those claims.

Claim 21 was rejected under the first paragraph of 35 U.S.C. §112 as not being commensurate in scope with the enabling disclosure herein. Claim 21 has been amended in accordance with the suggestion of the Examiner, thereby obviating this ground of rejection.

Claims 1-18, 21, and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,294,631 (Franz). The claims as amended herein relate to benzimidazole derivatives having, for instance, a monocyclic heteroaryl group linked to the phenyl group on the 1-position of the benzimidazole nucleus by a methylene

bridge. The Examiner maintains that the Franz disclosure "reads on the instant genus when ... R" is $(\text{alkyl})_m\text{CO}_2\text{R}^8$ ". Office Action, pages 3-4. The present amendment deletes the embodiments wherein R" represents $(\text{alkyl})_m\text{-CO}_2\text{R}^8$, and accordingly, it is respectfully submitted that claims 1, 4, 5, 7-10, 18, 21, and 22 as amended are patentable over the Franz disclosure.

Claims 1-18, 21, and 22 were rejected on the ground of obviousness-type double patenting as being unpatentable over claim 1 of US 6,503,925 B1. The claims herein in their present form are distinguished from the invention claimed in the '925 patent because the substituent R¹¹ therein does not include a monocyclic heteroaryl linked to the benzimidazole nucleus by a methylene bridge. Accordingly, withdrawal of the obviousness-type double patenting rejection over US 6,503,925 B1 is respectfully solicited.

Claims 1-18, 21, and 22 were rejected on the ground of obviousness-type double patenting as being unpatentable over claim 1 of US 6,649,609 B2. The claims herein in their present form are distinguished from the invention claimed in the '609 patent because the substituent R" therein is a non-aromatic carbocyclic or heterocyclic ring, while in the present invention a corresponding substituent is an **aromatic** heterocyclic ring. Accordingly,

withdrawal of the obviousness-type double patenting rejection over US 6,649,609 B2 is respectfully solicited.

Claims 1-18, 21, and 22 were rejected on the ground of obviousness-type double patenting as being unpatentable over claim 1 of US 6,710,044 B2. The claims herein in their present form are distinguished from the invention claimed in the '044 patent because the substituent R¹¹ therein is a morpholinyl group rather than a monocyclic heteroaryl group to be linked to the benzimidazole. Accordingly, withdrawal of the obviousness-type double patenting rejection over US 6,710,044 B2 is respectfully solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Richard Gallagher (Reg. No. 28,781) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional

fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly,
extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Gerald M. Murphy, Jr., #28,977

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

RG
GMM/RG/jmb
2815-0234P